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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Shlomo Touboul

FIN0006

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74877

7590

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King and Spalding LLP  
1700 Pennsylvania Ave, NW  
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Washington, DC 20006

EXAMINER

ANWARI, MACEEH

ART UNIT

PAPER NUMBER

2451

NOTIFICATION DATE

DELIVERY MODE

06/09/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/680,962	<b>Applicant(s)</b> TOUBOUL ET AL.	
	<b>Examiner</b> MACEEH ANWARI	<b>Art Unit</b> 2451	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to communications file on 2/18/2011. **Claim(s) 38 & 48** have been amended. **Claim(s) 1-37 & 58-90** have been canceled. No other claims have been amended, added, or canceled. Accordingly, **claim(s) 38- 57** are pending.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/04/2011 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to **claims 38- 57** have been considered but are moot in view of the new ground(s) of rejection.

4. Furthermore, regarding applicant's arguments that neither **Ng** nor **Shaikh** discloses: A) " embedding a control mark within an electronic document created by a document word processor, wherein a body of the document maybe changed by the document word processor but the control mark cannot be changed or removed by the document word processor"; B) monitoring transmitted network packets.

5. With respect to A), the examiner respectfully disagrees. The examiner would like to contest that there is no support for the detailed limitation(s) within the original

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specification. As such the examiner directs applicant to the 112 first paragraph rejection below, for further clarification.

6. With respect to B), the examiner respectfully disagrees. **Ng** discloses a method/system/mechanism for authenticating e-mail messages, through checking and extracting and authenticating embedded identifiers within a message. As such the examiner contends, that these e-mail messages (and in fact all e-mails) are made up of packets and by authenticating and verifying the message IDs within the message/packets then **Ng** is in fact monitoring them.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 38- 57** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner finds no support in applicant's original specification for the limitation(s):

i. **As per claim 38:**

Lines 3-6: Applicant states, "embedding a control mark within an electronic document created by a document word processor, wherein a body of the document maybe changed by the document word processor

but the control mark cannot be changed or removed by the document word processor”.

In fact examiner finds evidence to the contrary (i.e. supporting that the control mark can and maybe changed and/or tampered with) on page 8, lines 12-14 the original specification discloses:

“Whenever the document is intercepted by NERP module 110 in transit , Mark Scanner Module 160 checks the control mark to ensure that it is intact and has not been tampered with.”(emphasis added)

Hence, it is noted here that the control mark can be changed (i.e. not in tact and tampered with).

ii. **As per claim 48:**

Lines 5-9: This claim contains the same inconsistencies and ambiguities as those mentioned with respect to claim 38 above, and is therefore rejected for the same reasons and rationale.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 38-57** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language in the following claims is not clearly understood:

iii. **As per claim 38:**

Lines 7-10: It is unclear what is meant by “monitoring transmitted network packets, for detection of network packets containing the electronic document, based on the control mark, in order to block access to the electronic document from unauthorized recipients.” (Emphasis added) In particular it is unclear whether the “based on” portion is modifying the “monitoring” or the “detection” steps; the grammatical syntax (i.e. double commas) implies that it is modifying the “monitoring” step when it should be modifying the “detection” step. Furthermore, it is unclear whether the “in order to” limitation is modifying the “detection” step, the “monitoring” step, or somehow modifying the “based on the control mark” limitation. Applicant is advised to clarify these ambiguities in order to help forward prosecution.

iv. **As per claim 48:**

Lines 10-13: This claim contains the same inconsistencies and ambiguities as those mentioned with respect to claim 38 above, and is therefore rejected for the same reasons and rationale.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 38- 57** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ng (U.S. Pat. #: 6, 640,301 B1)** and further in view of **Shaikh (U.S. Pat. #: 7, 035, 830 B1)**.

13. Regarding **claim 38 Ng** discloses: a method for controlling access to and tracking the routing of an electronic document, comprising:

embedding a control mark (**Fig. 1 & 3A; digital signature, encryption, PGP**), within an electronic document created by the document word processor, (**Fig. 4 & 6; MSG ID'S, CKSUM KEYS, PAD all within email message body**); and

monitoring transmitted network packets, for detection of network packets containing the electronic document, based on the control mark, in order to block access to the electronic document from unauthorized recipients (**Fig. 7; extracting MSG ID, and Message verification**).

**Ng** discloses the invention as disclosed above.

**Ng** furthermore discloses that the body of the document may be changed by the document word processor (**Ng at least in Fig. 8A-9C, 11-12; compose email module for outgoing emails and various e-mail with respective replies**).

However, **Ng** does not appear to explicitly disclose wherein the control mark cannot be changed or removed by the electronic document and blocking access to the electronic document from unauthorized recipients.

In the same field of endeavor **Shaikh** discloses wherein the control mark cannot be changed or removed by the electronic document and blocking access to the electronic document from unauthorized recipients (**Shaikh: Fig. 2-5 and Abstract & col. 1 line 31- col. 2 line 7; electronic copy of document filed with permanent electronic stamp, and limiting access to the to the server/document to at least one authorized user**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine or modify **Shaikh's** teachings of remote filing and recordation of documents with those of **Ng's** to form a more secure and reliable messaging system (i.e. by allowing the filing of documents electronically as if—or with the same certainty—of doing so in person col. 2 lines 25-35).

14. Regarding **claim 39 Ng-Shaikh** further discloses: further comprising logging an audit record of the transmission, when a network packet containing the electronic document is detected by said monitoring, wherein the audit record stores information identifying a distribution route of the electronic document (**Fig. 10; Lookup tables and indexing IDs**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

15. Regarding **claim 40 Ng-Shaikh** further discloses: wherein said logging includes logging a date and time of the transmission in the audit record (**Fig. 8A-B; date and time fields**).



One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

16. Regarding **claim 41 Ng-Shaikh** further discloses: wherein said logging includes logging a destination of the transmission in the audit record (**Fig. 8A-B; “To” and “From” fields**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

17. Regarding **claim 42 Ng-Shaikh** further discloses: wherein said monitoring monitors network packets transmitted internally within an organization network (**Fig. 4 & 6-7; outgoing and incoming e-mail messages being monitored**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

18. Regarding **claim 43 Ng-Shaikh** further discloses: wherein said monitoring monitors network packets transmitted from within an organization network to outside of the organization network (**Fig. 4 & 6-7; outgoing e-mail messages via the Internet**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

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19. Regarding **claim 44 Ng-Shaikh** further discloses: wherein said monitoring monitors network packets transmitted to an organization network from outside of the organization network (**Fig. 4 & 6-7; in coming e-mail messages via the Internet**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

20. Regarding **claim 45 Ng-Shaikh** further discloses: wherein the network packets are transmitted in response to an FTP download (**Col. 15 lines 9-17; either E-mail or FTP can be used to send messages**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

21. Regarding **claim 46 Ng-Shaikh** further discloses: wherein the network packets are transmitted in response to an HTTP download (**Col. 2 lines 53- 62 and col. 15 lines 9-17; HTTP**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

22. Regarding **claim 47 Ng-Shaikh** further discloses: wherein the network packets are transmitted in response to an Instant Messenger download (**Col. 15 lines 9-17; other file transfer methods**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

23. Regarding **claims 48-57**, they list substantially the same elements found in **claims 38-47**, but in system form rather than method form, therefore **claims 48-57** are rejected using the same reasons and rationale as applied to **claims 38-47**.

24. **Claims 38- 57** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ng (U.S. Pat. #: 6, 640,301 B1)** and further in view of **Levy (U.S. Pub. #: 2004/0001606 A1)**.

25. Regarding **claim 38 Ng** discloses: a method for controlling access to and tracking the routing of an electronic document, comprising:

embedding a control mark (**Fig. 1 & 3A; digital signature, encryption, PGP**), within an electronic document created by the document word processor, (**Fig. 4 & 6; MSG ID'S, CKSUM KEYS, PAD all within email message body**); and

monitoring transmitted network packets, for detection of network packets containing the electronic document, based on the control mark, in order to block access to the electronic document from unauthorized recipients (**Fig. 7; extracting MSG ID, and Message verification**).

**Ng** discloses the invention as disclosed above.

**Ng** furthermore discloses that the body of the document may be changed by the document word processor (**Ng at least in Fig. 8A-9C, 11-12; compose**

**email module for outgoing emails and various e-mail with respective replies).**

However, **Ng** does not appear to explicitly disclose wherein the control mark cannot be changed or removed by the electronic document and blocking access to the electronic document from unauthorized recipients.

In the same field of endeavor **Levy** discloses wherein the control mark cannot be changed or removed by the electronic document and blocking access to the electronic document from unauthorized recipients (**Levy: Fig. 2-5 and Abstract & par. 4- 15 & 53; forensic tracking, invisible marking, digital watermarks, text watermarking or text steganography used to embedded invisible watermarks; hidden data must be robust to distortions, secure to hacking, and document usage control rules, limiting when a document can be reproduced).**

One of ordinary skill in the art at the time of the given invention would have been motivated to combine or modify **Levy's** teachings of invisible markings and control rules associated with the markings with those of **Ng's** to form a more secure and controlled messaging system (i.e. by limiting the when a document can be reproduced).

26. Regarding **claim 39 Ng-Levy** further discloses: further comprising logging an audit record of the transmission, when a network packet containing the electronic document is detected by said monitoring, wherein the audit record stores information identifying a distribution route of the electronic document (**Ng at least in Fig. 10;**

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**Lookup tables and indexing IDs. Levy: Fig. 2-5 and Abstract & par. 4- 15 & 53; rules controlling where and when document can be reproduced, tracking and labeling instructions that ensure visible label indicating the source, time and date of rendering, the number of copies etc.).**

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Levy**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

27. Regarding **claim 40 Ng-Levy** further discloses: wherein said logging includes logging a date and time of the transmission in the audit record (**Ng at least in Fig. 8A-B; date and time fields. Levy: Fig. 2-5 and Abstract & par. 4- 15 & 53; rules controlling where and when document can be reproduced, tracking and labeling instructions that ensure visible label indicating the source, time and date of rendering, the number of copies etc.).**

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Levy**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

28. Regarding **claim 41 Ng-Levy** further discloses: wherein said logging includes logging a destination of the transmission in the audit record (**Ng at least in Fig. 8A-B; “To” and “From” fields. Levy: Fig. 2-5 and Abstract & par. 4- 15 & 53; rules controlling where and when document can be reproduced, tracking and labeling instructions that ensure visible label indicating the source, time and date of rendering, the number of copies etc.).**

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Levy**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

29. Regarding **claim 42 Ng-Levy** further discloses: wherein said monitoring monitors network packets transmitted internally within an organization network (**Ng at least in Fig. 4 & 6-7; outgoing and incoming e-mail messages being monitored over various networks**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Levy**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

30. Regarding **claim 43 Ng-Levy** further discloses: wherein said monitoring monitors network packets transmitted from within an organization network to outside of the organization network (**Ng at least in Fig. 4 & 6-7; outgoing e-mail messages via the Internet**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Levy**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

31. Regarding **claim 44 Ng-Levy** further discloses: wherein said monitoring monitors network packets transmitted to an organization network from outside of the organization network (**Ng at least in Fig. 4 & 6-7; in coming e-mail messages via the Internet**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Levy**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

32. Regarding **claim 45 Ng-Levy** further discloses: wherein the network packets are transmitted in response to an FTP download (**Ng at least in Col. 15 lines 9-17; either E-mail or FTP can be used to send messages**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Levy**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

33. Regarding **claim 46 Ng-Levy** further discloses: wherein the network packets are transmitted in response to an HTTP download (**Ng at least in Col. 2 lines 53- 62 and col. 15 lines 9-17; HTTP**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Levy**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

34. Regarding **claim 47 Ng-Levy** further discloses: wherein the network packets are transmitted in response to an Instant Messenger download (**Ng at least in Col. 15 lines 9-17; other file transfer methods**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Levy**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

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35. Regarding **claims 48-57**, they list substantially the same elements found in **claims 38-47**, but in system form rather than method form, therefore **claims 48-57** are rejected using the same reasons and rationale as applied to **claims 38-47**.

**Examiner Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.**

### ***Prior Art***

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. **Chu (U.S. Pub. No.: 2002/0116531 A1)**, directed towards improving an end user's interaction with Web-based customer service programs (and the use of Web bugs for enabling information to be reported from the user's device to an application in the network, for tracking information about the user's session by including invisible miniature graphic images with a document).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MACEEH ANWARI whose telephone number is (571)272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.

/John Follansbee/  
Supervisory Patent Examiner, Art Unit 2451